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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,003	10/30/2003	Itzhak Bentwich	050992.0300.10USCP	1002
37808	7590	09/30/2008	EXAMINER	
ROSETTA-GENOMICS			SHIN, DANA H	
c/o PSWS				
700 W. 47TH STREET			ART UNIT	PAPER NUMBER
SUITE 1000				1635
KANSAS CITY, MO 64112				
			MAIL DATE	DELIVERY MODE
			09/30/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/707,003	BENTWICH, ITZHAK	
	<b>Examiner</b>	<b>Art Unit</b>	
	DANA SHIN	1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 13 May 2008.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 34-37 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 34 and 35 is/are allowed.  
 6) Claim(s) 36 and 37 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

Upon further consideration, new grounds of rejections are deemed proper. See below.

### ***Status of Application/Amendment/Claims***

This Office action is in response to the communications filed on May 13, 2008.

Currently, claims 34-37 are pending and under examination on the merits.

The following rejections are either newly applied or are reiterated and are the only rejections and/or objections presently applied to the instant application.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Response to Arguments and Amendments***

The declaration under 37 CFR 1.132 filed on May 13, 2008 is sufficient to overcome the rejection of claims 21-23 and 32-36 based upon lack of utility under 35 U.S.C. 101 and the first paragraph of 35 U.S.C. 112.

Applicant's arguments with respect to claims 21-23 and 32-36 have been considered but are moot in view of the claim amendment filed on May 13, 2008 and the new ground(s) of rejection. See below.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 37 is rejected under 35 U.S.C. 102(b) as being anticipated by Fodor et al. (US 2001/0053519 A1).

The claim is directed to a probe comprising the 24-nucleotide nucleic acid sequence SEQ ID NO:3588 or its complement.

Fodor et al. teach an isolated nucleic acid consisting of 25 nucleotides wherein the nucleotides are each A, C, T(or U), and G, wherein the nucleic acid is used as a probe. See claims 14-15. Accordingly, all claim limitations are taught by Fodor et al.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fodor et al. (US 2001/0053519 A1).

The claim is drawn to a vector comprising the 24-nucleotide nucleic acid sequence SEQ ID NO:3588.

Fodor et al. teach an isolated nucleic acid consisting of 25 nucleotides wherein the nucleotides are each A, C, T(or U), and G, wherein the nucleic acid is used as a probe. See claims 14-15. They also teach that a fragment of a genomic sequence (e.g., the 25-mer nucleotide) can be inserted into a vector. See paragraph 0041.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make a vector comprising the 24-mer of the claimed SEQ ID NO:3588, because it was known in the art to insert a fragment of a genomic sequence into a vector for expression or cloning purpose as taught by Fodor et al. Accordingly, the claimed invention taken as a whole would have been *prima facie* obvious at the time of filing.

### ***Conclusion***

Claims 34 and 35 appear to be free of the prior art searched of record.

Claims 36 and 37 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANA SHIN whose telephone number is (571)272-8008. The examiner can normally be reached on Monday through Friday, 7am-3:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James (Doug) Schultz can be reached on 571-272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Dana Shin  
Examiner  
Art Unit 1635

/J. E. Angell/  
Primary Examiner, Art Unit 1635